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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,263	03/22/2004	Lawrence E. Noble	19418/101/102	1928

5909 7590 04/27/2007
NAWROCKI, ROONEY & SIVERTSON
SUITE 401, BROADWAY PLACE EAST
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MINNEAPOLIS, MN 554133009

EXAMINER

POUS, NATALIE R

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/806,263	Applicant(s) NOBLE ET AL.	
	Examiner Natalie Pous	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 3731

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5... rejected under 35 U.S.C. 102(e) as being anticipated by Palmaz et al. (US 6190404).

Regarding Claim 1, Palmaz et al. teaches a vascular stent (200) having a generally cylindrical shape with an outer surface and an inner surface, the improvement comprising: at least one channel (400) in said outer surface.

Regarding Claim 2, Palmaz teaches the improvement according to claim 1 wherein said channel is oriented generally parallel to said cylindrical shape (Column 3, proximate lines 10-20).

Regarding Claim 3, Palmaz teaches the improvement according to claim 1 wherein said channel is oriented generally perpendicular to said cylindrical shape (Column 3, proximate lines 10-20).

Regarding Claim 4, Palmaz teaches the improvement according to claim 1 wherein said stent is machined to produce a pattern having at least one stent element (fig. 8).

Regarding Claim 5, Palmaz teaches the improvement according to claim 4 wherein said channel is machined in one of said at least one stent element (fig. 8).

Regarding Claim 7, Palmaz teaches an apparatus comprising: a. A vascular stent (200) having a generally cylindrical shape and having an outer surface; and b. A channel (400) located on said outer surface.

Regarding Claim 8, Palmaz teaches an apparatus according to claim 7 wherein said vascular stent further comprises a stent element (fig. 8).

Regarding Claim 9, Palmaz teaches an apparatus according to claim 8 wherein said channel is located on said stent element (fig. 8).

Regarding Claim 10, Palmaz teaches an apparatus according to claim 9 wherein said channel is generally parallel to said cylindrical shape (Column 3, proximate lines 10-20).

Regarding Claim 11, Palmaz teaches an apparatus according to claim 9 wherein said channel is generally perpendicular to said cylindrical shape (Column 3, proximate lines 10-20).

Regarding Claim 16, Palmaz teaches an apparatus comprising: a. Means for stenting a vessel having an outer surface (200); and b. Means located on said outer surface for enhancing perfusion (400).

Regarding Claim 17, Palmaz teaches an apparatus according to claim 16 further comprising means responsively coupled to said outer surface for imparting differential flexibility (400).

Regarding Claim 18, Palmaz teaches an apparatus according to claim 16 wherein said enhancing means further comprises a channel (400) within said outer surface.

Regarding Claim 19, Palmaz teaches an apparatus according to claim 18 wherein said outer surface has a pattern producing a stent element (fig. 8).

Regarding Claim 20, Palmaz teaches an apparatus according to claim 19 wherein said channel is located on said stent element in a generally parallel direction (Column 3, proximate lines 10-20).

Regarding Claim 21, Palmaz teaches an apparatus according to claim 19 wherein said channel is located on said stent element in a generally perpendicular direction (Column 3, proximate lines 10-20).

Claims 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. (US 6071305).

Regarding Claim 1, Brown teaches a vascular stent (11) having a generally cylindrical shape with an outer surface and an inner surface, the improvement comprising: at least one channel (20) in said outer surface.

Regarding Claim 4, Brown teaches the improvement according to claim 1 wherein said stent is machined to produce a pattern having at least one stent element (fig. 1).

Regarding Claim 5, Brown teaches the improvement according to claim 4 wherein said channel is machined in one of said at least one stent element (fig. 1).

Regarding Claim 6, Brown teaches the improvement according to claim 5 wherein said channel contains a medication (23).

Claims 12-15 are being treated as product by process limitations, in that the "machining a channel into the stent and embedding medication," refers to the process of making the device and not to the final product created. As set forth in the MPEP 2113, "Even though product-by-process claims are limited by and defined by the process,

determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (See MPEP §2113). Examiner will thus evaluate the product claims without giving much weight to the method of its manufacture.

It appears the product disclosed by Brown would be the same and would perform equally well as that *claimed*; especially since both applicant's product and the prior art have the same final shape and structure of a stent having a channel with a medicine embedded in the channel.

Regarding Claim 12, Brown teaches a method of preparing a vascular stent comprising: a. Securing a bio-compatible tube (12) having a generally cylindrical shape with an outer surface (16); and b. Providing a channel (20) in said outer surface.

Regarding Claim 13, Brown teaches a method according to claim 12 further comprising creating a pattern in said bio-compatible tube producing a stent element (fig. 1).

Regarding Claim 14, Brown teaches the method according to claim 13 wherein said providing step further comprises machining said channel into said stent element (Column 5, proximate lines 45-50).

Regarding Claim 15, Brown teaches method according to claim 14 further comprising the step of embedding a medication (23) into said channel.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NRP
4/15/07


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
